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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/633,820	08/04/2003	Brian D. Zelickson	43154.70	7509

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EXAMINER	
LACYK, JOHN P	

ART UNIT	PAPER NUMBER
3736	

DATE MAILED: 03/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/633,820	ZELICKSON ET AL.	
	Examiner	Art Unit	
	John P Lacyk	3736	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *21 December 2004*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *75-94* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *75-94* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

2. Claims 75-94 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sogawa et a in view of Abele et al.

Sogawa et al disclose a device having an antenna device surrounded by a balloon-like member, with tubes for feeding and draining a cooling liquid to and from the inside of the balloon, the antenna connected to a microwave source of energy for heating of tissue (column 1, lines 13-23; column 1, line 59- column 2, line 20; column 3, lines 8-29 and column 3, line 53- column 4, line 3). Sogawa et al lack an insertion device having a proximal and distal end, wherein the insertion device (an endoscope, for example) is capable of insertion into a body opening. Abele et al disclose a device for treating tissue inside a patient's body having an antenna device surrounded by a balloon member, with tubes for feeding and draining a cooling liquid to and from the inside of the balloon, the antenna connected to an RF source of energy for heating of tissue, and further comprising an insertion device in the form of an endoscope (150 and column 1, line 27- column 2, line 2; column 3, line 45- column 4, line 16 and column 6, lines 9-26). Therefore a modification of Sogawa et al to provide device through an endoscope would have been obvious to one skilled in the art in view of Abele et al as an alternative means of positioning the energy source or antenna element adjacent tissue to be

treated and as a means for observing or viewing the tissue before, during and after the treatment.

Further with respect to claims 81 and 87, Sogawa et al, disclose the output power of the oscillator (energy source) can be on the order of 10-200 watts, and that the desired temperature of the tissue being treated (heated) is controlled by this power, the rate of flow of the circulating fluid, and a temperature sensor feeding a signal to an automatic controller. Thus it would have been obvious to one of ordinary skill in the art that the Sogawa et al device is capable of heating the tissue to between 63-65 degrees C (or 50-70 C) in a time period between 1 microsecond and 1 minute, as required by the procedure.

Further with regard to the specific tissue this is directed to the intended use of the device and as such fails to provide any further patentable limitations. With regard to claims 84-85, 88, 92 and 94, Sogawa et al further discloses a means for cooling surface tissue to prevent tissue damage while the energy transmitting device radiates energy by circulating a fluid through the device and controlling its rate of flow, wherein the means for cooling dissipates heat generated in the surface tissue to maintain a temperature below 50 C in the surface tissue (column 3, lines 8-29). For claim 76, Sogawa et al discloses a source frequency of 300-3000 Mhz, which is the UHF band of RF and overlaps the microwave range (column 2, lines 12-18). For claims 78-80, Sogawa et al teaches a linear dipole antenna which by design radiates into a 180 degree angle or in the "forward direction", thus a "directional antenna".

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 75-94 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-12 of U.S. Patent No. 6,604,004. Although the conflicting claims are not identical, they are not patentably distinct from each other because the patent is directed to a species or a more specific embodiment while the application is directed to the genus or broader embodiment. However since the patent is already issued to the species it would anticipate the genus. The pending claims are broader in scope with the elimination of the observation and control pieces and a plurality of antenna, which are claimed in further dependent claims.

5. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within

TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John P Lacyk whose telephone number is 571-272-4728. The examiner can normally be reached on Mon-Fri, 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Max Hindenburg can be reached on 571-272-4726. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

John P Lacyk
Primary Examiner
Art Unit 3736

J.P. Lacyk